

Docket No. 030186U2

Serial No. 10/770,878

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 29 2006

In Re Application of:
Rowitch, et al.

For: LOCATION BASED SERVICE (LBS)
SYSTEM, METHOD AND APPARATUS
FOR TRIGGERING OF MOBILE
STATION LBS APPLICATIONS

Serial No.: 10/770,878

Group Art Unit: 2683

Filed: February 2, 2004

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Ariel A. Balaoing
Examiner

Dear Sir:

Appellants respectfully request review of the final rejection mailed by the Office for the above-referenced application on March 31, 2006 ("the Final Office Action").

A Notice of Appeal is being filed concurrently herewith. This Request for Review is pursued for the reasons presented in the following pages.

I hereby certify that this correspondence is being deposited
via facsimile addressed to "Mail Stop AF, Commissioner for
Patents, P.O. Box 1450, Alexandria, VA 22313-1450", on:

June 29, 2006

(Date of Deposit)

Victoria J. Pacey

(Name of Person Making Deposit)

(Signature)

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Status of Claims

Claims 1-7 are pending in the application, and claims 8-12 are withdrawn. The Examiner has restricted claims 1-7 and 8-12 as directed to a process and apparatus for its practice. The Examiner states that claims 1-7 have been constructively elected through presentation of the claims for prosecution on the merits. Claims 8-12 are withdrawn in light of the restriction requirement.

Claims 1-3, 6, and 7 remain rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Publication No. 20040242209 to Kruis et al. (hereinafter Kruis) in view of U.S. Patent No. 6,138,003 to Kingdon et al. (hereinafter Kingdon). Claims 4 and 5 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Kruis and Kingdon and further in view of U.S. Patent No. 6,754,482 to Torabi (hereinafter Torabi).

Appellants believe the rejections contain clear factual deficiencies and do not properly set forth a *prima facie* case for the obviousness rejections.

The Examiner Fails to Establish a Prima Facie Case of Obviousness

Applicant contends that the references fail to teach, either alone or in combination, all of the claimed features. Additionally, there is no motivation to combine or otherwise modify the teachings of Kruis and Kingdon, or Kruis, Kingdon and Torabi in a manner that would teach the claimed invention. Thus, because there is no *prima facie* case for obviousness, the claims are believed to be allowable over the cited references.

Kruis is directed to self-provisioning of a mobile communication device. *Kruis*, Abstract. Kingdon is directed to authorization of location services to ensure that a requesting agency has authorization to request positioning of mobile terminals. *Kingdon*, Abstract. Neither Kruis nor Kingdon teach or suggest authenticating a Location Based Service (LBS) application run on a mobile station. Thus, the combination of Kruis with Kingdon also fails to teach or suggest authenticating a Location Based Service (LBS) application run on a mobile station.

The References Fail to Teach or Suggest Every Feature of Claim 1

Claim 1 recites a method for authenticating an application run on a mobile station. The method includes "attempting to run a Location Based Service (LBS) application on the mobile station." Claim 1 also includes "communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the LBS

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application.” The claim recites a LBS application and does not refer to an application exclusive of location based service.

Kruis, in contrast, relates to self-provisioning in a mobile communication device. As explained in Kruis, the provisioning process relates to initial activation of a newly purchased mobile device or adding, removing, or modifying mobile device related services offered by a network operator. *Kruis*, at Col. 1, paragraphs [0002]-[0003] and paragraph [0007].

Kruis also has no discussion of a Mobile Positioning Center (MPC). The Examiner concedes that Kruis fails to describe a location based service application and fails to describe communicating with the MPC, but contends that Kingdon teaches the claimed feature.

Applicant addresses this rejection in Applicant’s response of January 19, 2006 at pages 6-7. However, the following discussion is presented to address the Examiner’s response in the Office Action of March 31, 2006.

The Examiner cites to Kingdon, at Col. 2, ll. 19-29 as describing a position application residing in a mobile station. The Examiner concedes that this description appears in the background section, but states that the description is relevant to the invention disclosed in Kingdon.

Applicant contends that the description in the background section of a mobile station having a position application is not applicable to the invention described in Kingdon, when read in the context of the entire disclosure. The Examiner does not interpret the description of an application in a mobile station in the context of the entire description in Kingdon, but instead, interprets the single sentence from the background section in isolation.

In providing a description of the problem to be solved, Kingdon explicitly states: “Proper authorization and access capabilities must be provided to prevent misuse and allow the subscriber to have adequate control over the ability of *external parties* to determine his or her location.” *Kingdon*, at Col. 3, ll. 15-18 (*emphasis added*). Furthermore, Kingdon, in the description of Figure 4, describes “the authority of an agency 280 to position a mobile station (MS) 200 based upon criteria to be met by both the MS 200 and the requesting agency 280.” *Id.*, at Col. 6, ll. 30-32. Such a description would be redundant if both the agency and the mobile station were the same, as argued by the Examiner.

Moreover, Kingdon fails to describe requesting authentication of the LBS application. Kingdon fails to describe any request to authenticate an LBS. Instead, Kingdon describes authenticating an agency in response to a position location request. *See, Kingdon*, at Col. 4,

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II. 57-62 ("Initially, when a positioning request is received by a local (serving) or home Mobile Positioning Center (MPC) 270 (step 300), the local or home MPC 270 must verify the identity of the requesting agency 280 and the authority of that agency 280 to request positioning (step 310)").

Claim 1 also includes "communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the LBS application." Kingdon fails to describe any direct communication with a MPC in the context of fulfilling a request for authentication of an LBS application, in part, because Kingdon fails to describe a request for authentication. Kruis and Kingdon, whether alone or in combination, fail to teach or suggest every claimed feature. Thus, the Examiner fails to establish a *prima facie* case of obviousness of claim 1.

There Is No Motivation to Combine Kruis With Kingdon

There is no motivation to combine the teachings of Kruis with Kingdon. Kruis relates to system provisioning of a mobile device and Kingdon relates to authorizing position location services requested by an agency. There is nothing to suggest that the two are in any way related. For example, Kruis makes no mention or suggestion of communicating with a MPC and fails to describe a location based service application. Kingdon fails to relate position location with system provisioning.

The Examiner presents, as a motivation to combine Kruis with Kingdon, the ability to "allow[] the monitoring of program usage to a specific communication region." Office Action dated March 31, 2006, at page 5. Additionally, the Examiner responds to Applicant's arguments concerning a lack of motivation to combine by stating that "both [Kruis and Kingdon] relate to providing authorization to an application within a mobile device of a wireless communication system." *Id.*, at page 3.

However, the general motivations offered by the Examiner in no way suggest the specific modifications and combination argued by the Examiner in the rejections of the claims. The prior art must suggest the desirability of the claimed invention. *See, generally, MPEP 2143.01*. It is error to reconstruct the claimed invention from the prior art by using the claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

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The Examiner's motivations do not mention LBS applications or communicating with an MPC, yet the Examiner contends that the motivations would make it obvious to modify a system for self-provisioning a mobile device (Kruis) to be directed to LBS applications and have the specific communication with an MPC featured in Applicant's claims. Additionally, the Examiner suggests that these general motivations would lead one of ordinary skill in the art to select specific aspects of authenticating an LBS application run on a mobile station for inclusion and modification of Kruis. Applicant contends that this is an improper motivation to combine the specific teachings of the references in a manner that is neither suggested by the references themselves or the proffered motivation. Applicant contends that claim 1 is allowable at least for the reason that the Examiner provides no motivation to combine or modify the cited references in a manner that would lead one to the claimed invention.

The Dependent Claims Are Allowable As Dependent Upon An Allowable Base Claim

Claims 2-7 depend, either directly or indirectly, from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

Discussion of Provisional Obviousness-Type Double Patenting

Applicant notes that U.S. Application No. 10/769,420 has not issued as a patent. Applicant need not address the merits of the provisional double patenting rejection unless and until one of the instant application or application 10/769,420 issues as a patent, because the respective applicants may amend or otherwise take actions that obviate the rejection.

CONCLUSION

In light of the arguments presented above, the Applicants respectfully submit that the instant claims are patentable. Accordingly, reconsideration and allowance of this Application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: June 29, 2006

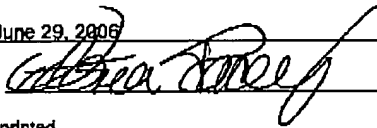

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JUN 29 2006

PTO/SB/33 (07-05)

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 030186U2 | |
|--|--|---|-------------------------------|
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" or being facsimile transmitted to the USPTO (571) 273-8300 [37 CFR 1.8(a)]</p> <p>on <u>June 29, 2006</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Victoria J. Pacev</u></p> | | Application Number 10/770,878 | Filed February 2, 2004 |
| | | First Named Inventor Douglas Rowitch | |
| | | Art Unit 2683 | Examiner Ariel A. Balaoing |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p>applicant/inventor.</p> <p>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p>attorney or agent of record. Registration number <u>43,721</u></p> <p>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><u></u> Signature Andrea L. Mays Reg. No. 43,721 Typed or printed name (858) 651-8546 Telephone number June 29, 2006 Date</p> | | | |
| *Total of <u>1</u> forms are submitted. | | | |

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DATE: 6/29/06

TO: Amendment
Commissioner for Patents

ATTN: Examiner: Ariel A. Balaoing
Art Unit: 2683

FAX NUMBER: (571) 273-8300

FROM: Andrea L. Mays, Attorney for Applicant
Registration No. 43,721

Total Number of Pages Sent: 3 (including this transmittal cover sheet)

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ATTORNEY DOCKET NO.: 030186U2

ENCLOSED ARE:

- Notice of Appeal (2 pages)
- Pre-Appeal Brief Request for Review

APPLICANT: Douglas Rowitch

ASSIGNEE: QUALCOMM Incorporated

SERIAL NO.: 10/770,878

FILED: March 31, 2006

FOR: LOCATION BASED SERVICE (LBS) SYSTEM, METHOD AND APPARATUS FOR TRIGGERING
OF MOBILE STATION LBS APPLICATIONS

Please contact Victoria J. Pacey at (858) 651-3411 if all pages do not transmit.

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